

**REMARKS**

Claims 1-24 were previously pending, of which claims 2, 5, 14 and 17 have been canceled; therefore, claims 1, 3-4, 6-13, 15-16 and 18-24 are currently pending in the application. Claim 1 has been amended to include the limitations of claims 2 and 5, now canceled. Claim 13 has been amended to include the limitations of claims 14 and 17, now canceled. Claim 24 has been amended such that the limitations added thereto are identical to those added to claims 1 and 13.

Reconsideration and allowance of the pending claims are respectfully requested in light of the foregoing amendments and the following remarks.

***Rejections Under 35 U.S.C. §103***

Claims 1, 3-4, 6-13, 15-16, and 18-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,270,946 to Shibasaki et al ("Shibasaki") in view of U.S. Patent No. 5,552,643 to Morgan et al. ("Morgan"). Applicants respectfully traverse the Examiner's position for the following reasons.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

**1. Even when combined, the references do not teach the claimed subject matter.**

The cited references cannot be applied to reject independent claims 1, 13 and 24 under 35 U.S.C. §103(a) because, even when combined, the references do not produce the claimed subject matter.

Claim 1, as amended, recites, in part, "wherein the first time periods are equal in duration to the second time periods." In addressing this language, which was previously included in claim 5 (now canceled), in paragraph 7 of the Office action, the Examiner concedes that "Shibasaki fails to teach the first time periods are equal in duration to the second time periods" and cites the Abstract of Morgan as teaching this element. Applicants respectfully traverse the Examiner's position in this regard and submit that, not only does the Abstract of

Morgan fail to address this limitation, it is clear from other portions of Morgan that the time periods are actually dependent on a variety of factors related to the respective power source  $PS_k$ , including, for example, the voltage  $V_k$  of the power source, and are not designed to be equal in duration. See, for example, claim 1 of Morgan, which indicates, at column 7, line 50, that:

$$t_k = ((2 p_k P_o L n T) / (V_k - V_o)^2)^{1/2}$$

As stated in the Abstract, under static load conditions, “the controller holds the corresponding duty period  $t_k$  for each signal $_k$  at a substantially constant value.” Holding each  $t_k$  **substantially constant** is not equivalent to holding all  $t_k$ s **equal**. Indeed, under dynamic load conditions, each  $t_k$  is dynamically adjusted “in order to maintain the fractional power contribution  $p_k$  for each signal $_k$  relative to the output power  $P_o$  at a predetermined value.” Abstract. It is apparent that Morgan not only fails to teach the subject limitation, it actually teaches away from the limitation. Clearly, therefore, the combination of references fails to teach, suggest, or render obvious all of the limitations of claim 1.

In view of the foregoing, for this mutually exclusive reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 1, as well as claims 3-4 and 6-12 dependent therefrom, under 35 U.S.C. §103 should be withdrawn and those claims allowed.

Claims 13, 15-16, and 18-23 include limitations similar to those of claims 1, 3-4 and 6-12; therefore, for at least the same reasons as set forth above with reference to claim 1, the rejection of claims 13, 15-16 and 18-23 under 35 U.S.C. §103 should be withdrawn and those claims allowed. Claim 24 includes limitations similar to those of claim 1; therefore, for at least the same reasons as set forth above with reference to claim 1, the rejection of claim 24 should be withdrawn and the claim allowed.

## 2. The combination of references is improper.

There is still another, mutually exclusive, and compelling reason why the Shibasaki and Morgan references cannot be applied to reject the claims under 35 U.S.C. §103.

§2142 of the MPEP also provides

[T]he examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown

and just before it was made. . . . The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'

In this context, the MPEP further provides at §2143.01

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Recently, the Supreme Court ruled that the longstanding "teaching, suggestion, or motivation (TSM) test" still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. \_\_, 11 (2007). The Court stated that "a patent composed of several elements is **not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art**. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a **reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does**. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, emphasis added.

In the present case, the Examiner has not expressed any valid reason why a person of ordinary skill in art would combine the battery selection control method and apparatus of Shibasaki with the power signal combination method and apparatus of Morgan in the way the claimed new invention does. In particular, as indicated above, Morgan actually teaches away from Applicants' claimed invention; therefore, there would be no incentive to combine the teachings thereof with Shibasaki in regard to the claimed invention. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection of the claims.

Accordingly, for this mutually exclusive reason, the Examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met, and the rejection of the pending claims under 35 U.S.C. §103 should be withdrawn.

### **Conclusion**

For at least the reasons set forth in detail above, independent claims 1, 13 and 24 are deemed to be in condition for allowance. Claims 2, 3-4, 6-12, 15-16 and 18-23 depend from

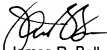
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and further limit independent claims 1 and 13 and are therefore also deemed to be in condition for allowance. Accordingly, Applicants respectfully request that the Examiner withdraw the pending rejections and issue a formal notice of allowance.

Respectfully submitted,



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